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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,200	02/17/2004	Ingo Irion	3827.124	9910

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PENDORF & CUTLIFF  
5111 MEMORIAL HIGHWAY  
TAMPA, FL 33634-7356

EXAMINER
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HOWELL, DANIEL W

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/780,200	Applicant(s) IRION ET AL. <i>ca</i>	
	Examiner Daniel W. Howell	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-16, 19 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-7, 17, 18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/958,704.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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1. The disclosure is objected to because of the following informalities: the first paragraph of the specification should be amended to indicate that the parent application has issued as US patent 6,712,367.

Appropriate correction is required.

2. Claims 1, 2, 17-18, and 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On the last line of claim 1, the structure "ring surface" improperly appears in parentheses. Considering how the dependent claims have been presented, it appears that "ring surface" should simply be deleted, as the term "free end" seems to have been used in the dependent claims.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7, 17-18, 20-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,712,367. Although the conflicting claims are not identical, they are not patentably distinct from each other. It is initially noted that lines 1-19 of present independent claims 1, 3, 8, and 10

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are identical, and each of these claims are modified versions of patented claim 1. The remaining lines of claims 1 and 3 are variations of the last four lines of patented claim 1 (as that claim appears in the printed patent). Comparing lines 1-19 of claims 1 and 3 to the corresponding section of patented claim 1, it is noted that the circumferential ring surface has been replaced with "first end," the "surface" of patented claim 1 has been changed to "second end," and "insulating material" has been changed to "non-conductive material." The changes to first end and second end are considered to be merely new terms for defining reference points on the structure, and as such are deemed to be obvious rewordings of patented claim 1. Similarly, the terms insulating and non-conductive are obvious variations of each other having essentially the same scope. Comparing the remaining lines of present claim 1 with the last four lines of patented claim 1, present claim 1 has retained the limitation that the pole shoe partially overlaps the free end, but the prior limitations that it "lies axially and/or radially against" the free end was deleted. Since the only way that the pole shoe could "partially overlap" the free end is in either an axial or radial sense, this change is considered to constitute an obvious rewording of the claim which doesn't effectively change the scope of the claim. Claim 3 reverses the situation by retaining the "axially and/or radially" language, but omitting the "partially overlaps" language, but this again doesn't effectively change the scope of the claim. It is noted that claim 2 contains the subject matter deleted from patented claim 1, present claims 4-7 correspond to patented claims 2-5, present claims 17-18 correspond to patented claims 13-14, and present claims 20-27, correspond to patented claims 16-24, and claim 28 includes subject matter deleted from patented claim 1.

5. Claims 8-16, 19, and 29 are allowed.

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6. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Andrea Wellington, may be reached at 571-272-4483.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.



Daniel W. Howell  
Primary Examiner  
Art Unit 3722